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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,931	05/01/2001	Ferdinand Kristen	DT-3899	3652
30377	7590	08/19/2004	EXAMINER	
DAVID TOREN, ESQ. SIDLEY, AUSTIN, BROWN & WOOD, LLP 787 SEVENTH AVENUE NEW YORK, NY 10019-6018			WEEKS, GLORIA R	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 08/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/846,931

Applicant(s)

KRISTEN ET AL.

Examiner

Gloria R Weeks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-10 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

1. This action is in response to the Appeal Brief received on June 1, 2004.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid et al. (USPN 4,456,076) in view of Ramarathnam (USPN 6,320,286).

In reference to claims 1-7, Schmid et al. discloses an electrical hand held tool, comprising an electric drive; an elastic spring (32); a first subassembly including an oscillating percussion mechanism (4) for transmitting the percussion movement to the working tool, a transformation gear (12, 17), a stator and a rotor (9) of the electrical drive and rotatable about a rotor axis extending parallel to an oscillation path of the percussion mechanism; and a second subassembly including a housing (1) in which the first subassembly is supported for a limited movement along a tool axis. Schmid et al. does not disclose the use of a brushless rotor, thereby having an oscillating percussion mechanism and oscillating rotor.

Ramarathnam teaches an electrical hand held tool comprising an electric drive; a first subassembly including transformation gear, a stator and a brushless rotor (figure 2; column 3, line 54) controlled by an electric control system (figure 4); and a second subassembly including a housing in which the first subassembly is supported, wherein the first subassembly and the

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second subassembly have substantially the same mass (column 6, line 59-column 7, line 13). It would have been obvious to one having ordinary skill in the art at the time of the invention to electric control system and rotor of Schmid et al. with the brushless rotor of Ramarathnam for the purpose of reducing overloads and stalling in the motor (column 1, lines 44-53).

4. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid et al. (USPN 4,456,076) in view of Ramarathnam (USPN 6,320,286) as applied to claim 7 above, and further in view of Ranger et al. (USPN 5,111,890).

Schmid et al. in view of Ramarathnam discloses an electrical hand-held tool according to claim 7, but does not disclose the use of a damping element arranged parallel to the spring means. Ranger et al. teaches a electrical hand held tool having a damping element (368) arranged parallel to a spring means (326). It would have been obvious to one having ordinary skill in the art at the time of the invention to further modify the hand-held tool of Schmid et al. to include the damping element of Ranger et al. for the purpose of reducing impact caused as a result of the spring force of the spring means.

Although Ranger et al. does not disclose the type of material of which the damping element is made, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a damping element made of viscous elastic material, since it has been held within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Furthermore, It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a material a viscous elastic material having an optimal energy dissipation at an operation

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temperature, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to attachment for notice of references cited and recommended for consideration based on their disclosure of limitations of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria R Weeks whose telephone number is (703) 605-4211. The examiner can normally be reached on 7:30 am - 6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott A Smith can be reached on (703) 308-2190. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



grw  
August 17, 2004

Gloria R Weeks  
Examiner  
Art Unit 3721



SCOTT A. SMITH  
PRIMARY EXAMINER